

Reconsideration and withdrawal of said requirement is respectfully requested. The Applicants respectfully submit that the requirement is not legally proper and should be withdrawn.

The Requirement is not legally proper because it is not timely

The Applicants respectfully submit that the restriction requirement in the Action dated April 21, 2004 is not in compliance with 37 C.F.R. § 1.146 which requires that a "species" restriction requirement is to be made in the first action on an application. The requirement is not in the first action taken in the application. In a previous Office Action, generic claim 1 was already fully examined. Thus, the requirement is not legally proper and should be withdrawn.

The Requirement is not legally proper because method claims are recited

The Applicants recite method claims. Thus, drawings are not required. Note MPEP § 608.02 and MPEP § 601.01(f).

The Action's apparent reliance on apparatus features in Figures 13, 40, 62, 63, and 68 (as the alleged species) is without merit. Process claims cannot be limited to an alleged species of a Figure.

Additionally, the ability of the Applicants to delete the (not required) drawing figures (and render the species restriction moot) is further evidence of the impropriety of the requirement. Would the Office prefer that Applicants delete all of the (not required) drawing Figures to render the species restriction moot? On this basis it is respectfully submitted that the requirement should be withdrawn.

The Requirement is not legally proper because there is no serious burden

MPEP § 803 sets forth criteria for a proper restriction requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for restriction to be required. Contrarily, if the search and examination of an entire application can be made without serious burden then the examiner must examine it on the merits.

Applicants respectfully submit that the requirement is not legally proper because the criteria for serious burden has not been met. Rather, the prosecution history is evidence that there never was a serious burden. That is, the application has already been searched, there has already been an examination, and the examination was on the merits. The prosecution record itself is clear evidence that there was (and continues to be) no serious burden. Again, the requirement is not legally proper and should be withdrawn.

The Requirement is not legally proper as a reasonable number of species are permitted

Applicants are entitled to a reasonable number of species. Even if it were somehow possible for the requirement to have been timely (which it wasn't) and for the examiner to show serious burden (which he can't), 37 C.F.R. § 1.146 still permits an application to have claims directed to a reasonable number of species. Applicants respectfully submit that even if the application had species as alleged, the number of species would still be reasonable, especially in light of the Office's lack of any evidence to the contrary. Again, the requirement is not legally proper and should be withdrawn.

**The Requirement is not legally proper
because a valid reason for species restriction is absent**

The “mutually exclusive characteristics” (MPEP § 806.04(f)) and the “relationship” (MPEP § 808.01(a)) of the alleged species have not been provided to Applicants. A valid reason why the indicated Figures 13, 40, 62, 63, and 68 are distinct species is absent in the Action.

In accordance with MPEP § 806.04(f), claims to be restricted to different species must be mutually exclusive. The "general test" as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which are found in a first species but not in a second species, while a second claim recites limitations only for the second species and not the first species. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

The Action has not indicated which claim recites limitations which are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first, as is required in order to meet the noted “general test” of MPEP § 806.04(f). Thus, the Action procedurally fails to present a valid reason for the requirement.

Where does the Action demonstrate that the alleged species are mutually exclusive (MPEP § 806.04(f))? For example, where does the Action show that alleged species are prevented from being used in the same embodiment? Where does the Action show that the other alleged species are specifically prevented from be used with alleged Species 5? Where does the Action provide a reason why the alleged Species 1 and the alleged Species 5 are mutually exclusive species? Likewise, where does the Action provide valid reasons of mutual exclusivity for the other alleged species. The Action has not shown that each alleged specie cannot be used

in an embodiment with another alleged specie. Rather, the Action's own allegations appear to be contrary to the general test for species being mutually exclusive.

The Action has not met the general test for mutually exclusive species. It follows that the Action has not met the test for a proper species restriction requirement. Thus, the requirement is improper and should be withdrawn.

Nor has the Office demonstrated where the alleged species occur in the claims, nor the common characteristic linking each of the alleged species. Applicants respectively disagree with the Actions' allegations and descriptions of species. For these reasons it is respectfully submitted that there is no valid basis for requiring species election. Thus, it is respectfully submitted that the requirement should be withdrawn.

The Requirement is not legally proper because it is incomplete/unclear

The Action does not meet the species restriction requirement criteria set forth in MPEP § 809.02(a). The Action does not "Identify generic claims or indicate that no generic claims are present" in accordance with MPEP § 809.02(a). Where does the Action state the complete status of all generic claims? Because the Requirement does not properly address the issue of all generic claims, Applicants have been denied information critical to their election decision. That is, Applicants have not been given a fair opportunity to make an informed election.

Nor does the Action clearly identify each of the alleged species *to which claims are restricted* in accordance with MPEP § 809.02(a). Where does the Action state how the alleged species are directed to different embodiments? Where does the Action correspond the claimed subject matter to the alleged species? For example, which claims correspond to alleged Species

1? Likewise, which claims respectively correspond to each of the alleged Species 2, 3, 4, and 5? Again, Applicants have not been given a fair opportunity to make an informed election.

The requirement does not properly describe the alleged distinct species. Nor are the alleged species clearly and properly presented. The Office has not indicated where the alleged species occur in the claims, nor the common characteristic linking the alleged species. The Action leaves Applicants the burden of properly responding to an unclear and improper requirement. Again, Applicants have not been given a fair opportunity to make an informed election. On this basis it is respectfully submitted that the requirement should be withdrawn.

The Action does not present a species restriction requirement based on the laws, rules, and Patent Office procedures. The Action at best pertains to allegations of species. The Action also appears to obfuscate the issues, because there is no proper species requirement to be made. For these reasons it is respectfully submitted that the requirement is improper. As there is no valid basis for requiring the species election requirement, it is respectfully submitted that the requirement should be withdrawn.

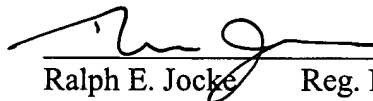
Applicants, as the requirement is best understood, have provisionally elected with traverse. However, Applicants reserve all rights to change or modify their election based on the alleged species requirement presentation being made a clearly understood and proper requirement.

Conclusion

The species requirement is respectfully traversed. The species requirement is not proper. Therefore, it is respectfully requested that the species requirement be withdrawn. Applicants further respectfully submit that this application is in condition for allowance.

The undersigned will be happy to discuss any aspect of the application by telephone at the Office's convenience.

Respectfully submitted,



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